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Filing date: **11/18/2005**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

<b>Proceeding</b>	91115866
<b>Party</b>	Defendant TREASURE ISLAND CORPORATION ,
<b>Correspondence Address</b>	ROBERT RYAN MORISHITA QUIRK & TRATOS SUITE 500 NORTH 3773 HOWARD HUGHES PARKWAY LAS VEGAS, NV 89109
<b>Submission</b>	Reply in Support of Motion
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<b>Signature</b>	/R. Richard Costello, Esq./
<b>Date</b>	11/18/2005
<b>Attachments</b>	ti_pi_reply.PDF ( 6 pages )

**UNITED STATES PATENT AND TRADEMARK OFFICE**  
**TRADEMARK TRIAL AND APPEAL BOARD**

Prairie Island Indian Community,  
a federally recognized Indian tribe,

Plaintiff,

vs.

Treasure Island Corp.,

Defendant.

Opposition Nos. 91115866 and  
91157981

Cancellation Nos. 92028126  
92028127; 92028130; 92028133;  
92028145; 92028155; 92028171;  
92028174; 92028199; 92028248;  
92028280; 92028294; 92028314;  
92028319; 92028325; 92028342;  
and 92028379 (as consolidated)

**Trademark Trial and Appeal Board**  
**Commissioner for Trademarks**  
**P.O Box 1451**  
**Alexandria, VA 22313-1451**

**DEFENDANT'S REPLY IN SUPPORT OF ITS MOTION TO STRIKE PLAINTIFF'S**  
**NOTICE OF RELIANCE UNDER RULE 2.122**

Defendant, Treasure Island Corp. ("Treasure Island"), files this Reply in support of its Motion To Strike Plaintiff's Notice of Reliance as it fails to comply with Trademark Rule 2.122. For the reasons set forth below and based upon the pleadings and materials contained in the file, Treasure Island respectfully requests that its Motion to Strike be granted.

**BACKGROUND**

Prairie Island has stated to the Board that judgment has been entered in its favor in connection with Cancellation Nos. 92028127, 92028174, 92028314, 92028319, and 92028325 on the grounds of "priority of use and likelihood of confusion." See Petitioner/Opposer's Memorandum in Response to Registrant/Applicant's Motion to Strike Opposer's Notice under Rule 2.122. The Board may recall that Treasure Island presented evidence that as the marketing position of many Las Vegas hotel casino resorts evolved from family-oriented themed resorts to more adult-oriented destination resorts, Treasure

Island felt certain some of its marks and the corresponding registrations were no longer useful and discontinued them as a result of a good faith business decision based on a new demographic strategy and market positioning. See Defendant's Response to OSC re Cancellation for Failure to File Section 8 Affidavit dated July 12, 2004 in the Prosecution History of Cancellation No. 92028325.

In addition, although the proceedings are consolidated, "each proceeding retains its separate character." Visa Int'l Serv. Ass'n v. CKC Holdings, Inc., 2005 WL 2464004 (Trademark Tr. & App. Bd.). Like the Board's decision in Visa, the Board's decision in this proceeding should also "take into account any differences in the issues raised by the respective pleadings." Id. In other words, even though some of Treasure Island's marks were voluntarily discontinued in good faith for marketing and strategy reasons, not all of its marks should be interpreted as being voluntarily discontinued, and that each of Treasure Island's mark in each proceeding should be evaluated independently on its own merit. The Board should take note that there are separate issues associated with each mark.

### **EXECUTIVE SUMMARY**

Prairie Island's Notice of Reliance should be stricken from the record in its entirety because 1) the e-mails and the state registration fail to qualify to enter into "evidence" under a Notice of Reliance, 2) Prairie Island fails to identify which section of the TTAB and Evidence Rules would permit the e-mails to be entered as records under a Notice of Reliance, and 3) Prairie Island's state registration fails to comply with Trademark Rule 2.122(e). Accordingly, the Board should deny these documents to be entered as records.

### **E-MAILS**

Prairie Island's e-mails fail to qualify as evidence because they were not properly introduced into evidence through the testimony of a person who can properly authenticate and identify them. Fed. R. Evid. 902(11). Federal Rules of Evidence states that business records kept in the course of a regularly conducted business activity must be authenticated or certified under Rule 902(11), Rule 902(12), or a statute permitting certification. Fed. R. Evid. 803(6). Since Prairie Island can cite no statute permitting

certification and has failed to offer the e-mails through the testimony of a person who can properly authenticate, identify, or certify them, the e-mails should be stricken from the record.

Additionally, Prairie Island should also be denied the opportunity to enter the e-mails into record through a Notice of Reliance because the e-mails were not produced during discovery nor through the testimony of any witness who could authenticate the records. Moreover, since Prairie Island did not produce the e-mails to Treasure Island until after Prairie Island has completed its testimony period, Treasure Island was denied the opportunity to depose any Prairie Island witnesses about these documents or to cross-examine the witnesses Prairie Island offered during its testimony period.

Prairie Island admits that it did not retrieve the e-mails until September 28, 2005, a week before it filed its Notice of Reliance under Rule 2.122. See Petitioner/Opposer's Memorandum in Response to Registrant/Applicant's Motion to Strike Opposer's Notice under Rule 2.122. Prairie Island further admits that these records were produced after Prairie Island has completed its testimony period. Because of that late disclosure, Treasure Island was not afforded the opportunity to question any witnesses on the veracity, source, or authenticity of these e-mails, nor was Treasure Island afforded the opportunity to contest the contents of the e-mails.

While Prairie Island argues that Treasure Island has the opportunity to question witnesses relevant to these documents, Prairie Island has not identified a knowledgeable witness. Additionally, it would be unfair to require Treasure Island to examine a Prairie Island witness or these documents during Treasure Island's testimony period because such an examination provides Prairie Island with the opportunity to introduce into evidence the very materials it failed to introduce during its own testimony period.

Furthermore, the e-mails are highly questionable on their face because they identify a different domain or hostname than the one previously used and identified by Prairie Island, namely, some of the e-mails identify a hostname of <ticasino.com> while other e-mails identify a hostname of <treasureislandcasino.com>. See Petitioner/Opposer's

Notice under Rule 2.122 Exhibits on pages 22 and 91. Since e-mails are ordinary text and can be easily manipulated, they must be deeply scrutinized and require a higher level of authentication or certification.

Prairie Island bears the burden of authenticating documents it seeks to enter into record. Attempting to have previously undisclosed documents accepted by the Board through a Notice of Reliance after Treasure Island's discovery period has closed defeats Treasure Island's ability to conduct written discovery or to challenge the authenticity of these documents. Prairie Island's argument that Treasure Island has the ability to question witnesses subsequent to Prairie Island's filing of a Notice of Reliance is as effective as closing the barn door after all the horses have bolted. In order to question witnesses, Treasure Island would have to conduct discovery regarding inter alia, the domain names, the websites, maintenance, storage, and retrieval of the documents. The counsel for Prairie Island was given every opportunity to enter these e-mails into evidence and yet failed to do so.

Although Treasure Island attempted to analyze the contents of these e-mails in this reply, Treasure Island does not concede that such action should be interpreted as consenting to having the e-mails entered into record.

#### **STATE REGISTRATION**

Prairie Island's attempt to enter the Minnesota State Registration Mark into record through a Notice of Reliance by citing the language of TMBP § 704.03(b)(1), which in turn cites to 37 C.F.R. § 2.122(e), should be denied because the illegible photocopy of the registration fails to meet the requirements of either § 704.03 or § 2.122. As stated in TMBP § 704.03(b)(1):

A state registration owned by a party to a Board inter-parties proceeding may be made of record therein by notice of reliance under 37 CFR § 2.122(e), or by appropriate identification and introduction during the taking of testimony, or by stipulation of the parties.

Under Rule 2.122(e), official records must "be accompanied by the official record or a copy thereof whose authenticity is established under the Federal Rules of Evidence," whereby

the authenticity of an official record is established by offering either the original record or a certified copy of that record. Fed. R. Evid. 902. The registration offered by Prairie Island is an illegible photocopy where an ordinary observer would have difficulty just trying to identify the name of the Secretary of State of Minnesota. Because Prairie Island's copy of the Minnesota State Registration Mark is neither the original record nor is it a certified copy of that record, the registration fails the requirements of Trademark Rule 2.122(e) and Federal Rules of Evidence.

Further, since Prairie Island neither identified nor introduced the Minnesota State Registration Mark during the taking of testimony, Prairie Island has failed to meet the requirements of TMBP § 704.03. Finally, the parties have not stipulated to allow the record to be introduced.

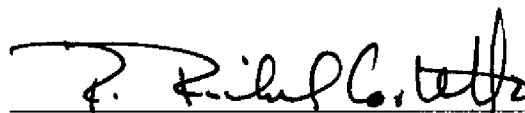
For all of the above reasons, the Minnesota State Registration Mark should not be admitted into evidence through a Notice of Reliance.

### **CONCLUSION**

For the foregoing reasons, Treasure Island respectfully requests that Treasure Island's Motion to Strike be granted and that the Board strike Prairie Island's Notice of Reliance in its entirety under Trademark Rule 2.122.

DATED: November 18, 2005

**GREENBERG TRAURIG**  
**fka Quirk & Tratos**



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**CERTIFICATE OF SERVICE**

I hereby certify that I served the foregoing **DEFENDANT'S REPLY IN SUPPORT OF ITS MOTION TO STRIKE PLAINTIFF'S NOTICE OF RELIANCE UNDER RULE 2.122** on:

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11/18/05

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by causing a full, true, and correct copy thereof to be sent by the following indicated method or methods, on the date set forth below:

- ☒ by mailing in a sealed, first-class postage-prepaid envelope, addressed to the last-known office address of the attorney, and deposited with the United States Postal Service at Las Vegas, Nevada.
- ☐ by hand delivery.
- ☐ by sending via overnight courier in a sealed envelope.
- ☐ by faxing to the attorney at the fax number that is the last-known fax number.
- ☒ by electronic mail to the last known e-mail address.

DATED: November 18, 2005.

  
An employee of GREENBERG TRAURIG

**CERTIFICATE OF SERVICE**